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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DARYL E. ANDERSON and JOHN STEPHEN DUNFIELD

Appeal 2008-4644
Application 10/613,842
Technology Center 3700

Decided: December 22, 2008

Before DONALD E. ADAMS, ERIC GRIMES, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a device for administering a fluid (e.g., a medicine) to the eye. The Examiner has rejected the claims for obviousness-type double patenting, anticipation, and obviousness. We have jurisdiction under 35 U.S.C. § 6(b). Because the Examiner has interpreted the claims more broadly than is reasonable in light of the Specification, we reverse all of the rejections on appeal.

STATEMENT OF THE CASE

The Specification discloses devices for “improving the introduction or instillation of fluids into the eye, for example by applying wetting solutions to the eye or for administering therapeutic agents that treat ocular conditions” (Spec. 2: 4-7).

Claims 1-20 and 22-32 are on appeal.¹ Claims 1, 20, and 28 are the independent claims and read as follows:

1. An ophthalmic apparatus comprising:
 - an eye-positioning device for assisting a subject in positioning an eye in a desired position for administering a fluid to the eye; and
 - an applicator for dispensing the fluid into the eye when the eye is in the desired position.
20. An ophthalmic apparatus, comprising:
 - a dispensing apparatus for dispensing fluid into an eye of a subject;
 - an eye-position detector for detecting the current position of the eye relative to the dispensing apparatus; and
 - a feedback device for providing feedback information that assists the subject in moving the eye from the current position to a predetermined position relative to the dispensing apparatus for administering the fluid to the eye.
28. An ophthalmic apparatus for administering a liquid to an eye of a subject, comprising:
 - detecting means for detecting the position of the eye; and
 - dispensing means for dispensing the liquid into the eye when the eye is in a predetermined position.

¹ Claims 33-42 are also pending but have been withdrawn from consideration by the Examiner (Appeal Br. 2).

The claims stand rejected as follows:

- Claims 1-4, 6, 17, 18, 28, and 30-32 for obviousness-type double patenting based on claims 1-49 of Anderson;²
- Claims 9-16 for obviousness-type double patenting based on claims 1-49 of Anderson combined with Bertera;³
- Claims 20 and 22 for obviousness-type double patenting based on claims 1-49 of Anderson combined with Vo;⁴
- Claims 1-6, 8-10, 14-16, 18, 19, and 28-31 under 35 U.S.C. § 102(b) as anticipated by Yee;⁵
- Claims 11-13, 17, and 32 under 35 U.S.C. § 103 as obvious in view of Yee and Bertera;
- Claim 7 under 35 U.S.C. § 103 as obvious in view of Yee and Miwa;⁶
- Claims 20, 22, and 23 as obvious in view of Yee and Vo; and
- Claims 24-27 under 35 U.S.C. § 103 as obvious in view of Yee and Wickham.⁷

The Issue

The Examiner has rejected all of the pending claims, on various grounds. Each of the Examiner's rejections, however, depends on the same claim interpretation: The Examiner interprets *eye position*, as referred to in

² Anderson et al., U.S. Patent 7,201,732 B2, issued April 10, 2007.

³ Bertera, U.S. Patent 5,368,582, issued Nov. 29, 1994.

⁴ Vo, U.S. Patent 5,171,306, issued Dec. 15, 1992.

⁵ Yee, U.S. Patent 6,270,467 B1, issued Aug. 7, 2001.

⁶ Miwa, U.S. Patent 6,299,305 B1, issued Oct. 9, 2001.

⁷ Wickham et al., U.S. Patent 6,159,186, issued Dec. 12, 2000.

each of the independent claims, as including whether an eye is open or closed (i.e., blinking). (See, e.g., Answer 12 (“[T]he device of Yee assists a user in moving their eye from an open to a closed position that occurs during blinking of the eye.”); and *id.* at 15 (“[C]laims 1-49 of the Anderson patent are directed to a device that assists a user in moving their eye from an open to a closed position that occurs during blinking of the eye.”)).

Appellants contend that the blink monitor disclosed by Yee does not detect eye position, as required by claims 20 and 22-32, because “blink monitor 16 monitors whether an eyelid has moved to cover an eye. Because an eye can be in any position when blinking, blink monitor 16 doesn’t monitor the position of an eye” (Appeal Br. 10).

Similarly, Appellants contend that the blink monitor in the device claimed by Anderson does not assist in positioning an eye, as required by claims 1-19, because an “eye-positioning device assists a user [to] orient his eye into a desired position relative to his eye socket. In contrast, a blink detector detects an eye-blink event, which is the motion of an eyelid over an eye. Detectors that detect whether a user has blinked do not . . . assist a user to move an eye to a desired position” (*id.* at 22-23).

The dispositive issue presented by this appeal, therefore, is: Did the Examiner err in interpreting eye position to include whether an eye is open or closed?

Findings of Fact

1. The Specification discloses “an ophthalmic apparatus and methods for its use. In one embodiment, the ophthalmic apparatus includes an

eye-positioning device for assisting a subject in positioning an eye in a desired position for administering a fluid.” (Spec. 2: 10-13.)

2. The Specification states that the apparatus “may include a feedback mechanism . . . to assist the user in moving the eye to the desired position for administering the fluid. . . . For example, the feedback signals can be vocalizations, such as, ‘move eye to right,’ ‘move eye to left,’ ‘move eye down,’ ‘move eye up,’ or similar instructions.” (*Id.* at 4:31 to 5:6.)

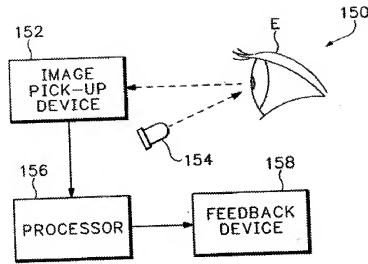
3. The Specification states that the “apparatus also may include a controller for manually or automatically dispensing the fluid from the dispenser at selected times and at specified rates” (*id.* at 5: 7-9).

4. The Specification states that the “user can select, via [a software] program, the specific location on the eye surface on which the fluid is to be dispensed, such as the corner or center of the eye” (*id.* at 5: 25-27).

5. The Specification states that the apparatus can include “detecting means for detecting the position of the eye and dispensing means for dispensing the liquid into the eye when the eye is in a predetermined position” (*id.* at 8: 24-26).

6. The Specification states that, “[i]n some applications, to effectively administer a fluid, it may be necessary to apply the fluid to a specific location on the ocular surface, such as the corner or lower portion of the eye. To such ends, an eye-positioning system can be implemented to facilitate proper positioning of one or both eyes for administering the fluid.” (*Id.* at 15: 31 to 16: 3.)

7. Figure 4 of the present application is reproduced below:



The figure shows one embodiment of an eye-positioning system (*id.* at 16: 3-4).

8. The eye-positioning system shown in Figure 4 includes “a processor 156 to determine whether the eye is in the proper position for administering a fluid to a selected location on the surface of the eye. In this manner, the image pick-up device 152 and the processor 156 serve as an eye-position detector for detecting the position of the eye.” (*Id.* at 16: 10-14.)

9. The eye-positioning system shown in Figure 4 includes a “feedback device 158 . . . that assists the user in moving the eye to a position relative to a fluid dispenser that will enable the fluid dispenser to dispense the fluid onto the selected location on the eye surface” (*id.* at 16: 18-21).

10. The Specification states that “[i]n one implementation, the feedback device generates vocalizations instructing the patient to move the eye to a specific position for administering a fluid. The vocalizations can be, for example, simple instructions, such as ‘up,’ ‘down,’ ‘left,’ ‘right,’ and ‘hold’” (*id.* at 17: 2-5).

11. The Specification states that the “eye-positioning system can provide feedback in the form of a visual target to assist a patient to position the eye in a desired position” (*id.* at 19: 26-27).

12. “[F]or example, an eye-positioning system includes a miniature display . . . that displays a real-time image of the eye along with a target. . . . The target is positioned on the display such that when the patient aligns a reference location of the eye (e.g., the pupil), the eye is in the desired position for administering the fluid.” (*Id.* at 19: 28 to 20: 2).

13. The Specification describes the operation of an embodiment of the disclosed apparatus as follows:

a user or health care professional selects the dosage of the fluid to be applied to an eye and the location on the eye that is to receive the fluid. This information is inputted into the processor. . . . The selected location on the eye can be a specific location or a general area on the surface of the eye. The processor 156 then determines . . . the position for the eye relative to a fluid dispenser . . . that will allow fluid to be dispensed onto the selected location of the eye.

(*Id.* at 18: 1-9.)

14. The Specification states that the processor determines eye-position by determining the position of a reference point on the eye (e.g., the pupil) relative to a fixed reference point (e.g., a fixed point on an adjacent fluid dispenser) (*id.* at 18: 12-18).

15. The Examiner has not identified any reference to blinking in the present Specification.

Principles of Law

“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000).

“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Analysis

The Examiner has interpreted eye position, as referred to in each of the independent claims on appeal, as including whether the eye is open or closed. Claim terms must be interpreted, however, consistently with their use in the supporting specification. In this case, we conclude that the Examiner’s interpretation is inconsistent with the Specification’s use of the term “eye position.”

The Specification states, for example, that the purpose of the eye-positioning system described in the Specification, and recited in certain claims, is to determine whether the eye is in the proper position for administering a fluid to a specific location *on the surface of the eye*. A system that determined only whether the eye was open would not serve the purpose described for the eye-positioning system.

In another example of the Specification using “eye position” in a manner inconsistent with the Examiner’s interpretation, the Specification

repeatedly refers to the position of the eye *relative to a fluid dispenser* or other fixed reference point. Whether an eye is open or closed does not change the eye's position relative to any outside reference point.

Finally, the eye-positioning systems are described in the Specification as providing feedback to users to move their eyes up, down, left, or right, or alternatively to focus on an image so as to align a reference location on the eye with a target. All of the described embodiments, therefore, change the position of the eye with respect to the eye socket and outside reference points, rather than changing the state of the eye between open and closed. Interpreting the claim language consistently with the Specification requires interpreting eye position to mean the position or orientation of the eye relative to the eye socket or an outside reference point.

The Examiner has pointed to no description in the Specification that would support interpreting eye position to include open or closed (blinking). In our view, the Examiner's interpretation of eye position is broader than would be considered reasonable by a person of ordinary skill in the art reading the term in light of the Specification's disclosure.

CONCLUSION OF LAW

The Examiner erred in interpreting eye position to include whether an eye is open or closed.

SUMMARY

All of the Examiner's rejections require interpreting eye position to include whether an eye is open or closed. We therefore reverse all of the rejections on appeal.

REVERSED

dm

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